

REMARKS

This Amendment is submitted in reply to the Office Action mailed on September 1, 2005. In the Office Action, the Examiner rejected claims 1-51. With this Amendment, claims 14, 15, 18, 36, and 37 are amended; no claims are cancelled; and no new claims are added. Upon entry of this Amendment, the above-identified application will include claims 1-51.

Claim Rejections Under The Written Description Requirement of 35 U.S.C. 112, 1st Paragraph

In the Office Action, the Examiner rejected claims 11-18, 25, 26, 29-37, 46, and 49 under 35 U.S.C. 112, 1st paragraph, as allegedly failing to satisfy the written description requirement found in the first paragraph of 35 U.S.C. §112. In support of this rejection, the Examiner provided the following comments:

Claims 11-18, 25, 26, 29-37, 46, and 49 are rejected under 35 U.S.C. 112, 1st paragraph as each being claims which fail to have a corresponding supporting disclosure present within applicants' disclosure. For example, the "Static Angle Test" referred to on page 26 of the specification is nowhere described in the application and the document referred to by applicants which presumably contains such an enabling disclosure thereof is also not believed to be suitably described; it is believed that claims 25, 26, 46, and 49 recite parameters taken from this test but unfortunately applicants' specification clearly appears to be non enabling on this particular issue. The remaining rejected claims are also believed to lack a suitable corresponding disclosure in the specification, which should be amended to include same.

Despite these comments, Applicants assert that claims 11-18, 25, 26, 29-37, 46, and 49 do in fact find support in the above-identified application and consequently do satisfy the written description requirement stated in the first paragraph of 35 U.S.C. §112.

We first consider claims 25, 26, 46, and 49 that a feature achievable by the present invention when subjected to static angle testing. The Examiner alleges the above-identified application does not provide the Static Angle Test procedure. This allegation is erroneous since a detailed explanation of the Static Angle Test procedure is provided at line 18, page 20, through line 19, page 21. After the Examiner reviews the Static Angle Test procedure provided by Applicants in the present application, in combination with the details provided in the various Examples of the application, Applicants are confident the

Examiner will recognize the above-identified application contains an adequate written description in support of the features provided in claims 25, 26, 46, and 49.

Next, we consider claim 11, which reads as follows:

11. *(Original) A mixture, the mixture comprising polymerizable substances, the polymerizable substances comprising:
at least one C_N alkyl(meth)acrylate monomer, where N is any integer ranging from 4 to 14; and
a cationic unsaturated vinyl comonomer.*

With regard to the “at least one C_N alkyl(meth)acrylate monomer” recited in claim 11, the Examiner is directed to page 4, lines 4-20, of the present application. With regard to the cationic unsaturated vinyl comonomer recited in claim 11, the Examiner is directed to line 21, page 4, through line 8, page 5, of the above-identified application. With regard to the mixture that comprises the polymerizable substances provided in claim 11, the Examiner is directed to (A) page 12, lines 17-22, (B) line 23, page 13, through line 14, page 14, and (C) lines 6-10 on page 3 of the above-identified application.

After the Examiner reviews the passages referred to above from the present application, Applicants are confident the Examiner will recognize the above-identified application contains an adequate written description in support of the features provided in claim 11. Similar comments apply with regard to claim 31 that recites cationic microspheres “derived in part from a C_N alkyl(meth)acrylate monomer where N is any integer ranging from 4 to 14”.

Next, we consider claim 12 that reads as follows:

12. *(Original) The mixture of claim 11 wherein the at least one C_N alkyl(meth)acrylate monomer comprises iso-octyl acrylate.*

The Examiner is directed to lines 12-14 on page 4 of the present application which describes isooctyl acrylate as an example of the at least one C_N alkyl(meth)acrylate monomer. After the Examiner reviews the passage referred to above from the present application, Applicants are confident the Examiner will recognize the above-identified application contains an adequate written description in support of the features provided in claim 12.

Next, we consider claim 13 that reads as follows:

- 13 *(Original) The mixture of claim 11 wherein the polymerizable substances further comprise an unsaturated vinyl comonomer.*

The Examiner is directed to (A) lines 6-12 on page 3 of the present application and to (B) line 9 on page 5 through line 28 on page 7 of the present application which describes the unsaturated vinyl comonomer that may be incorporated in the claim 11 mixture as another polymerizable substance when forming the cationic microspheres of the present invention. After the Examiner reviews the passages referred to above from the present application, Applicants are confident the Examiner will recognize the above-identified application contains an adequate written description in support of the features provided in claim 13. Similar comments apply with regard to claim 32 that recites cationic microspheres "derived in part from an unsaturated vinyl comonomer."

Next, we consider claim 14 that reads as follows:

- 14. A coating composition, the coating composition comprising:
cationic microspheres based on the mixture of claim 11; and
a cationic latex adhesive binder.*

The Examiner is directed to (A) lines 29-31 on page 3 of the present application and to (B) line 5 on page 11 through line 6 on page 12 which describes the cationic latex adhesive binder that may be incorporated in the claim 14 coating composition in accordance with the present invention. After the Examiner reviews the passages referred to above from the present application, Applicants are confident the Examiner will recognize the above-identified application contains an adequate written description in support of the features provided in claim 14. Similar comments apply with regard to claim 33 that recites incorporation of "a cationic latex adhesive binder in the adhesive composition" prepared in accordance with claim 29.

Next, we consider claims 15 and 16 that read as follows:

- 15. (Amended) The coating composition of claim 14 wherein the mixture further comprises a cationic surfactant.*

- 16. (Original) The mixture of claim 11 wherein the mixture further comprises a cationic surfactant.*

The Examiner is directed to (A) lines 13-17 on page 3 of the present application, to (B) lines 14-32 on page 8 of the present application, to (C) lines 23-27 on page 13 of the present application, and to (D) lines 4-14 on page 14 of the present application which, in accordance with claims 15 and 16, describes incorporation of a cationic surfactant in the polymerizable mixture leading to formation of the cationic microspheres in accordance

with the present invention. After the Examiner reviews the passages referred to above from the present application, Applicants are confident the Examiner will recognize the above-identified application contains an adequate written description in support of the features provided in claims 15 and 16. Similar comments apply with regard to claims 34 and 35 that recite incorporation of "a cationic surfactant in the adhesive composition" prepared in accordance with claims 29 and 33.

Next, we consider claim 17 that reads as follows:

17. (Original) The mixture of claim 11 wherein the mixture further comprises a catalyzation initiator.

The Examiner is directed to (A) line 3 on page 15 of the present application and to (B) line 29 on page 7, through line 14 on page 8 of the present application which, in accordance with claim 17, describes incorporation of a catalyzation initiator in the polymerizable mixture leading to formation of the cationic microspheres in accordance with the present invention. After the Examiner reviews the passages referred to above from the present application, Applicants are confident the Examiner will recognize the above-identified application contains an adequate written description in support of the features provided in claim 17.

Next, we consider claim 18 that reads as follows:

18. (Amended) The mixture of claim 11 wherein polymerization of the polymerizable substances is effective to form cationic microspheres.

The Examiner is directed to (A) lines 6-24 on page 3 of the present application and to (B) line 7, page 12, through line 24, page 14, of the present application which, in accordance with claim 18, describes polymerization of the polymerizable substances to form cationic microspheres in accordance with the present invention. After the Examiner reviews the passages referred to above from the present application, Applicants are confident the Examiner will recognize the above-identified application contains an adequate written description in support of the features provided in claim 18.

Next, we consider claim 29 that reads as follows:

29. (Original) A method of making an adhesive composition, the method comprising:

causing a plurality of cationic microspheres to exist in a fluidizing medium to yield the adhesive composition, the fluidizing medium effective for supporting fluid application of the adhesive composition to a surface.

The Examiner is directed to (A) lines 17-25 on page 2 of the present application, to (B) lines 13-17 and lines 23-27 on page 3 of the present application, and to (C) lines 1-7 on page 15 of the present application which, in accordance with claim 29, describes fluidizing medium that contains the cationic microspheres and supports fluid application of the adhesive composition to a surface in accordance with the present invention. After the Examiner reviews the passages referred to above from the present application, Applicants are confident the Examiner will recognize the above-identified application contains an adequate written description in support of the features provided in claim 29.

Next, we consider claim 30 that reads as follows:

30. (Original) The method of claim 29 wherein the cationic microspheres have a cationic charge that is permanently and individually bound to each cationic microsphere.

The Examiner is directed to lines 18-22 on page 18 of the present application which, in accordance with claim 30, describes a cationic charge that is permanently and individually bound to each cationic microsphere in accordance with the present invention. After the Examiner reviews the passage referred to above from the present application, Applicants are confident the Examiner will recognize the above-identified application contains an adequate written description in support of the features provided in claim 30.

Next, we consider claim 36 that reads as follows:

*36. (Original) An adhesive article, the adhesive article comprising:
a substrate; and
a coating of the adhesive prepared in claim 29 on the substrate, the adhesive effective to allow positioning of the adhesive article on a first application surface and repositioning of the adhesive article on a second application surface.*

The Examiner is directed to (A) lines 17-25 on page 2 of the present application, to (B) lines 5-13 on page 11 of the present application, to (C) line 24, page 15, through the bottom (line 31) of page 16 of the present application, and to (D) lines 1-8 on page 18 of the present application which, in accordance with claim 36, describes a substrate with an attached adhesive of the present invention, where the adhesive is described as “effective to allow positioning of the adhesive article on a first application surface and repositioning of the adhesive article on a second application surface” in accordance with the present invention. After the Examiner reviews the passage referred to above from the present

application, Applicants are confident the Examiner will recognize the above-identified application contains an adequate written description in support of the features provided in claim 36.

Finally, we consider claim 37 that reads as follows:

37. (Amended) The adhesive article of claim 36 wherein the adhesive composition is effective to allow the repositioning of the adhesive article from the first application surface to the second application surface without leaving any visible residue of the adhesive composition on the first application surface, the visible residue being any residue that is visible to the unaided eye of a human being.

The Examiner is directed to lines 3-19 on page 19 of the present application which, in accordance with claim 37, describes the adhesive composition of the present application as being effective to allow the repositioning of the adhesive article comprising the adhesive composition from a first application surface to a second application surface without leaving any visible residue of the adhesive composition on the first application surface, where the visible residue is defined as any residue that is visible to the unaided eye of a human being.” After the Examiner reviews the passage referred to above from the present application, Applicants are confident the Examiner will recognize the above-identified application contains an adequate written description in support of the features provided in claim 37.

Claims 11-18, 25, 26, 29-37, 46, and 49 are believed allowable despite the Examiner’s rejection of these claims under the written description set forth in the first paragraph of 35 U.S.C. §112. Consequently, Applicants respectfully request that the Examiner reconsider and withdraw the rejection of claims 11-18, 25, 26, 29-37, 46, and 49 under the first paragraph of 35 U.S.C. §112 and that claims 11-18, 25, 26, 29-37, 46, and 49 be allowed.

Claim Rejection Based on the Howard Patent Under 35 U.S.C. 102(b) and 35 U.S.C. 103(a)

In the Office Action, the Examiner rejected claims 1, 4, 7-10, 29, 36 and 37 under 35 U.S.C. 102(b) as allegedly being anticipated by U.S. Patent No. 4,598,112 to Howard (subsequently referred to as “the Howard patent”) or, in the alternative, under 35 U.S.C. 103(a) as allegedly being obvious considering the Howard patent. In support of this rejection, the Examiner provided the following comments:

Claims 1, 4, 7-10, 29, 36 and 37 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Howard. Note particularly the Abstract, Col 1, line 28- Col 2, line 15, Claim 1. The reference discloses a repositionable acrylate adhesive composition, coated articles and methods of making the adhesive wherein the adhesive may simply be a plurality of cationic microspheres immersed in a film forming binder, which is substantially all that at least the majority of these claims require. As to claims 9 and 37, the absence of adhesive residue is believed to be either inherent, or alternatively an obvious modification to one of ordinary skill.

Despite these comments, the Howard patent does not disclose each and every feature required by claims 1, 4, 7-10, 29, 36 and 37 and consequently does not anticipate any of 1, 4, 7-10, 29, 36 or 37. Additionally, the Howard patent fails to teach, suggest, or make obvious the invention of the above-identified application, as defined in claims 1, 4, 7-10, 29, 36 and 37.

The Howard patent describes preparation of a low tack glue that incorporates polymeric microspheres. (Howard patent: line 67, column 1, through line 3, column 2). The Howard patent emphasizes that the polymeric microspheres “are derived from non-ionic monomers.” (Howard patent: lines 3-6, column 2). The Howard patent states that a suspension stabilizer and a cationic emulsifier are used during the polymerization technique employed to form the polymeric microspheres. (Howard patent: lines 6-8, column 2).

The Howard patent, with reference to U.S. Patent No. 4,166,152 of Baker et. al., states:

The anionic emulsifiers retard particle coalescence [in a composition containing microspheres (i.e. particles)] by surrounding the particle with a negatively charged double layer which provides repulsion of the individual particles.

(Howard patent: lines 24-27, column 1; clarifying comments in brackets added). The Howard patent then mentions preparation of a low tack glue containing microspheres, where the glue is prepared using a cationic emulsifier, as opposed to the anionic emulsifier disclosed in the Baker patent, so a cationic charge is associated with the microspheres in the glue of the Howard patent. (Howard patent: lines 55-58 and 39-42, column 1). Thus, the Howard patent is concerned with forming a glue containing microspheres that are surrounded by a positively charged layer (instead of the negatively charged layer of the Baker patent) by virtue of using a cationic emulsifier in the glue (as opposed to the anionic emulsifier of the Baker patent) to retard particle (microsphere) coalescence. This last point is confirmed by the following language employed in claim 1 of the Howard patent: "wherein the microspheres are surrounded by a cationic surfactant which prevents particle coalescence." (Howard patent: lines 15-17, column 4).

Thus, though the Howard patent employs the language "cationic microspheres" (line 46, column 1) and talks about "cationically (positively) charged" microspheres (lines 40-41, column 1), it is clear the Howard patent is not actually producing microspheres that incorporate a structural cationic charge. Instead, the microspheres of the Howard patent, while in the glue composition, are surrounded by the cationic (positively charged) surfactant so that the combination of the microspheres and the surrounding surfactant have a net cationic charge.

Claim 1 of the above-identified application reads as follows:

1. (Original) *An adhesive composition, the adhesive composition comprising:
a plurality of cationic microspheres; and
a fluidizing medium effective for supporting fluid application of the
adhesive composition to a surface.*

Thus, claim 1 defines an adhesive composition that comprises a fluidizing medium and cationic microspheres. The above-identified application makes it very clear the cationic microspheres defined in claim 1 are very different from the microspheres employed in the Howard patent.

First, the present application states the cationic microspheres are derived, in part, from one or more cationic unsaturated vinyl comonomers:

Cationic polymeric elastomeric microspheres (also referred to herein as "cationic microspheres") that are produced in accordance with the present

invention are a reaction product of certain polymerizable substances. The polymerizable substances include at least one C₄-C₁₄ alkyl (meth) acrylate monomer and one or more cationic unsaturated vinyl comonomers.

(Lines 6-10, page 3, of the above-identified application). The Howard patent, on the other hand, employs microspheres that are derived "from non-ionic monomers." (Howard patent: lines 3-6, column 2). Thus, the microspheres of the Howard patent are based on non-ionic monomers, while the cationic microspheres of the present application are based in part on cationic comonomers.

Another distinction is the reaction mixture employed to form adhesive composition that comprises the cationic microspheres of the present application may, but does not necessarily, include a cationic surfactant:

The polymerizable substances are included as part of a reaction mixture in the course of preparing the cationic microspheres. In addition to the polymeric substances, the reaction mixture also includes one or more catalyzation initiators. The reaction mixture will typically also include a fluidizing medium, such as deionized water, and a surfactant, such as a cationic surfactant.

(Lines 13-17, page 3, of the above-identified application). The Howard patent, on the other hand, necessarily employs a cationic surfactant (emulsifier) during preparation of the low tack glue that comprises the Howard microspheres. (Howard patent: lines 6-8, column 2).

Finally, the present application states the cationic microspheres are cationically charged. The following details about this cationic charge of the cationic microspheres are provided in the present application:

. . . . Furthermore, the cationic microspheres included in the repositionable PSA have a cationic charge. Though not being bound to any particular theory, it is believed the cationic charge of the cationic microspheres included in the repositionable PSA is part of, and is permanently bound to, the individual cationic microspheres. It is believed the chemical component of the cationic microspheres that causes the cationic microspheres to carry the cationic charge is a structural portion of the cationic microspheres that is permanently and chemically bound within each and every cationic microspheres. The cationic microspheres are therefore believed to be unsusceptible to losing the cationic charge.

(Lines 18-26, page 18, of the above-identified application). Thus, the present application states a chemical component of the cationic microspheres that causes the cationic

microspheres to carry the cationic charge is believed to be a structural portion of the cationic microspheres and that this chemical component that contributes the cationic charge in the cationic microspheres is believed to be permanently and chemically bound within the different cationic microspheres. The Howard patent, on the other hand, includes no such structural component that contributes a cationic charge to the Howard microspheres. Instead, the Howard microspheres have an associated cationic charge due to the cationic surfactant which surrounds the microspheres and thereby “prevents particle coalescence.” (Howard patent: lines 15-17, column 4).

The Examiner apparently bases his anticipation rejection on Applicants’ use of the term “cationic microspheres” in claim 1 and upon the infrequent use of the term “cationic microspheres” in the Howard patent. However, this cursory approach to alleging anticipation is inappropriate. Resort to the specification of the above-identified application to understand the meaning of the “term “cationic microspheres” is necessary and appropriate. As detailed above, such resort to the specification clearly illustrates that the cationic microspheres defined in claim 1 are different from the microspheres disclosed in the Howard patent.

The need to understand the meaning of the term “cationic microspheres” recited in claim 1 is all the more important once claim 7 of the present application that depends from claim 1 is considered. Claim 7 recites that the adhesive composition of claim 1 “further comprises a cationic surfactant. The entire basis for infrequently referring to the microspheres of the Howard patent as “cationic microspheres” is the use of the cationic surfactant during preparation of the low tack glue of the Howard patent that includes the microspheres. If the Examiner considers the cationic microspheres of claim 1 to be anticipated by the microspheres of the Howard patent, the Examiner’s apparent basis relies on the use of the cationic surfactant during preparation of the low tack glue of the Howard patent that includes the microspheres. However, this basis of the Examiner of apparently characterizing the cationic microspheres of claim 1 of the present application as meaning microspheres with an associated cationic surfactant would result in claims 1 and 7 defining the same details. Such a result is inappropriate under the well known doctrine of claim differentiation. Therefore, for this additional reason, it is clear the meaning of the

term “cationic microspheres” of claim 1 of the present application must be interpreted in light of the specification details noted above.

The Howard patent fails to disclose the “cationic microspheres” defined in claim 1 of the present application. The cationic microspheres recited in claim 1 are defined in the present application in terms of a chemical component of the cationic microspheres that causes the cationic microspheres to carry the cationic charge and is believed to be a structural portion of the cationic microspheres. The present application further defines that this chemical component that contributes the cationic charge in the cationic microspheres is believed to be permanently and chemically bound within the different microspheres. The Howard patent, on the other hand, includes no such structural component that contributes a cationic charge to the Howard microspheres. Instead, the Howard microspheres have an associated cationic charge due to cationic surfactant which surrounds the microspheres.

Consequently, the Howard patent fails to disclose each and every detail required by claim 1 and consequently does not anticipate claim 1. Since the meaning of the term “cationic microspheres” recited in claim 29 is the same as the meaning of the term “cationic microspheres” recited in claim 1, the Howard patent likewise also fails to disclose the cationic microspheres required by claim 29 and consequently does not anticipate claim 29.

The Howard patent also fails to teach, suggest, or disclose the invention of the above-identified application, as defined in claims 1 and 29. This is evident since the Howard patent relies on the cationic surfactant, apparently standing alone, to surround and associate cationic charge with the Howard microspheres that are based only on non-ionic monomers. (Howard patent: lines 3-6, column 2). There is no teaching, suggestion, or motivation based on the disclosure of the Howard patent to instead include a cationically-charged chemical component as a structural portion of the Howard microspheres so the chemical component that contributes the cationic charge in the cationic microspheres is permanently and chemically bound within the various Howard microspheres, as required by the cationic microspheres recited in claims 1 and 29. The only conceivable basis for the Examiner’s apparent suggestion for the switch from surrounding microspheres with cationically charged surfactant, per the Howard patent, to incorporating a chemical

component bearing cationic charge as a structural component of the microsphere, per claims 1 and 29 would be to rely on the teachings of the specification of the present application as a road map via hindsight reconstruction. However, it is well known that such hindsight reconstruction is an improper basis for alleging obviousness.

Claims 1 and 29 are believed allowable. Claims 4 and 7-10 are also believed allowable, since claims 4 and 7-10 each depend from allowable claim 1. Likewise, claims 36 and 37 are each believed allowable, since claims 36 and 37 each depend from allowable claim 29. Consequently, Applicants respectfully request that the Examiner reconsider and withdraw both the rejection under 35 U.S.C. 102(b) based on the Howard patent and the rejection under 35 U.S.C. 103(a) based on the Howard patent and that claims 1, 4, 7-10, 29, and 36-37 be allowed.

Claim Rejection Based on the Howard Patent and the Crandall Patent Under 35 U.S.C. 103(a)

In the Office Action, the Examiner rejected claims 1-51 under 35 U.S.C. 103(a) as allegedly being obvious considering the Howard patent in combination with U.S. Patent No. 5,756,625 to Crandall et. al. (subsequently referred to as "the Crandall patent"). In support of this rejection, the Examiner provided the following comments:

Claims 1-51 are rejected under 35 U.S.C. 103(a) as being unpatentable over Howard combined with Crandall et al. Howard is again relied upon substantially as set forth, above, while Crandall et al discloses (note particularly the Abstract, Col 1, lines 10-19, Col 3, line 43 – Col 4, line 37, Col 6, line 59 – Col 9, line 54, Col 10, lines 26 - 36, Examples) what essentially appears to comprise applicants' broad genus of cationic adhesive microspheres that are suitable for forming the claimed genus of repositionable adhesive compositions, together with the accompanying methods of making and using, various adhesive compositions, coated articles and the like. The references are clearly combinable, each featuring repositionable adhesive compositions which feature cationic microspheres, with the microspheres of Crandall et al improving the adhesive compositions of Howard by incorporating their microspheres in place of the Howard microspheres, motivated by (Col 3, lines 44 - 47) an expectation of enhanced stability and performance properties, while maintaining inherent tackiness, elastomeric properties and solvent or water dispersibility. Other parameters that are not either expressly or inherently disclosed are each believed to be routine optimizations to one of ordinary skill, in the absence of unexpected results.

Despite these comments, the Howard patent and the Crandall patent, either separately or in combination, fail to teach, suggest, or make obvious the invention of the above-identified application, as defined in claims 1-51.

The Crandall patent discloses microspheres based optionally in part on a comonomer, where the optional comonomer may be nonpolar, ionic, polar, or mixtures thereof. (Crandall patent: lines 59-63, column 6, and lines 1-2, column 7). Examples of suitable comonomers are provided. (Crandall patent: line 13, column 8, through line 50, column 9). However, no teaching or example of a cationic unsaturated vinyl comonomer is provided anywhere within the text, examples, or claims of the Crandall. Indeed, the Examiner did not even allege the Crandall patent teaches, suggests, or discloses the cationic unsaturated vinyl comonomer(s) disclosed and claimed in the above-identified application. Furthermore, the Examiner did not identify any particular optional comonomer disclosed in the Crandall patent as an example of the cationic unsaturated vinyl comonomer(s) disclosed and claimed in the above-identified application. Instead, the Examiner chose to rely on the broad, conclusory contention about the Crandall patent allegedly disclosing "what essentially appears to comprise applicants' broad genus of cationic adhesive microspheres." Despite this allegation, Applicants assert the Crandall patent does not teach, suggest, disclose, or make obvious the cationic unsaturated vinyl comonomer(s) disclosed and claimed in the above-identified application. If the Examiner continues to rely on the Crandall patent, the Examiner is invited to point out where in the Crandall patent the Examiner believes there is disclosure or teaching of such cationic unsaturated vinyl comonomer(s).

The Crandall patent also discloses incorporation of a vinyl unsaturated additive along with the polymerizable components that are polymerized to form the microspheres. (Crandall patent: lines 59-66, column 6). Examples of suitable vinyl unsaturated additives are provided. (Crandall patent: line 43, column 7, through line 12, column 8). There is no disclosure in the Crandall patent about the vinyl unsaturated additive being polymerized to form part of the microsphere. Furthermore, the Examiner has not alleged the vinyl unsaturated additive is polymerized to form part of the microsphere. Instead, the Crandall patent teaches the vinyl unsaturated additive helps prevent the microspheres that are formed from coagulating during synthesis. (Crandall

patent: lines 16-27, column 16). Further evidence that the vinyl unsaturated additive is not polymerized to form part of the microsphere is found in claim 1 of the Crandall patent. Claim defines a “stabilized microsphere adhesive composition” that comprises, among other elements, “a plurality of polymeric, elastomeric microspheres . . .” and the vinyl unsaturated additive. (Crandall patent: lines 39-51, column 18). Thus, the Crandall patent does not teach, suggest, or disclose anything about the vinyl unsaturated additive being polymerized to form part of the microsphere. Instead, the Crandall patent teaches, suggests, and discloses the vinyl unsaturated additive is not polymerized and does not form part of the microsphere.

Claims 11, 19, and 38 read as follows:

11. (Original) *A mixture, the mixture comprising polymerizable substances, the polymerizable substances comprising:
at least one C_N alkyl(meth)acrylate monomer, where N is any integer ranging from 4 to 14; and
a cationic unsaturated vinyl comonomer.*

19. (Original) *An adhesive, the adhesive comprising:
a polymerized product of polymerizable substances, the polymerized product adhesively repositionable between different application surfaces, the polymerizable substances comprising:
at least one C_N alkyl(meth)acrylate monomer, where N is any integer ranging from 4 to 14; and
a cationic unsaturated vinyl comonomer.*

38. (Original) *A method of making adhesive cationic microspheres, the method comprising:
initiating reaction of a polymerizable mixture to form the adhesive cationic microspheres, the polymerizable mixture comprising:
at least one C_N alkyl(meth)acrylate monomer, where N is any integer ranging from 4 to 14; and
a cationic unsaturated vinyl comonomer.*

Each of claims 11, 19, and 38 thus define a cationic unsaturated vinyl comonomer that is described as a polymerizable substance (claims 11 and 19), a component of a polymerized product (claim 19), or part of a polymerizable mixture (claim 38). As explained above, the Crandall patent does not teach, suggest, or discloses a cationic unsaturated vinyl comonomer that is described as a polymerizable substance. Instead, the Crandall patent

merely teaches polymerizable ionic, but not cationic, comonomers. (Crandall patent: lines 59-63 , column 6, and lines 1-2, column 7).

The Crandall patent thus fails to teach suggest, disclose or make obvious the invention of the above-identified application, as defined in claims 11, 19, and 38. The Examiner's suggestion of substituting the Crandall microspheres in place of the Howard microspheres adds nothing in regard to claims 11, 19, and 38 since neither the Crandall patent nor the Howard patent teaches, suggests, or discloses a cationic unsaturated vinyl comonomer that is described as a polymerizable substance.

Next, claims 1 and 29 read as follows:

1. *(Original) An adhesive composition, the adhesive composition comprising:*

*a plurality of cationic microspheres; and
a fluidizing medium effective for supporting fluid application of the
adhesive composition to a surface.*

29. *(Original) A method of making an adhesive composition, the method comprising:*

*causing a plurality of cationic microspheres to exist in a fluidizing
medium to yield the adhesive composition, the fluidizing
medium effective for supporting fluid application of the
adhesive composition to a surface.*

Thus, claims 1 and 29 each require a plurality of "cationic microspheres." From the discussion above, it has been established that the term "cationic microspheres" of the claims 1 and 29 means microspheres that include a cationically-charged chemical component as a structural portion of the microspheres, where the chemical component that contributes the cationic charge in the cationic microspheres is permanently and chemically bound within the different microspheres.

As pointed out previously in regard to the Examiner's rejection based solely on the Howard patent, there is no teaching, suggestion, or motivation based on the disclosure of the Howard patent to include a cationically-charged chemical component as a structural portion of the Howard microspheres so the chemical component that contributes the cationic charge in the cationic microspheres is permanently and chemically bound within the various Howard microspheres, as required by the cationic microspheres recited in claims 1 and 29. The Crandall patent, as noted above, does not teach, suggest,

or disclose a polymerizable cationic unsaturated vinyl comonomer. Instead, the Crandall patent merely teaches polymerizable ionic, but not cationic, comonomers. (Crandall patent: lines 59-63, column 6, and lines 1-2, column 7). Consequently, there is no teaching, suggestion, or motivation based on the disclosure of the Crandall patent to include a cationically-charged chemical component as a structural portion of the Crandall microspheres so the chemical component that contributes the cationic charge in the cationic microspheres is permanently and chemically bound within the various Crandall microspheres, as required by the cationic microspheres recited in claims 1 and 29.

The only conceivable basis for the Examiner's apparent suggestion of deriving the Crandall microsphere from a cationically-charged chemical component that is included as a structural portion of the Crandall microspheres that contributes the cationic charge in the cationic microspheres and is permanently and chemically bound within the various Crandall microspheres, per claims 1 and 29, would be to rely on the teachings of the specification of the present application as a road map via hindsight reconstruction. However, it is well known that such hindsight reconstruction is an improper basis for alleging obviousness.

Thus, the Examiner's rejection based on the Howard patent and the Crandall patent fails. Even if the microspheres of the Crandall patent were substituted in place of the Howard patent, per the Examiner's suggestion, the resulting combination would still fail to include a cationically-charged chemical component as a structural portion of the microspheres so the chemical component that contributes the cationic charge in the cationic microspheres is permanently and chemically bound within the various microspheres, as required by the cationic microspheres recited in claims 1 and 29.

Claims 1, 11, 19, and 29, and 38 are each believed allowable. Claims 2-10 are also believed allowable, since claims 2-10 each depend from allowable claim 1. Additionally, claims 12-18 are each believed allowable, since claims 12-18 each depend from allowable claim 11. Also, claims 20-28 are also believed allowable, since claims 20-28 each depend from allowable claim 19. Next, claims 30-37 are each believed allowable, since claims 30-37 each depend from allowable claim 29. Likewise, claims 39-51 are each believed allowable, since claims 39-51 each depend from allowable claim 38. Consequently, Applicants respectfully request that the Examiner reconsider and withdraw the rejection under 35 U.S.C. 103(a) based on the Howard patent and the Crandall patent and that claims 1, 51 be allowed.

CONCLUSION

Claims 1-51 are believed allowable. Therefore, reconsideration and allowance of claims 1-51 is respectfully requested. The Examiner is invited to contact Applicants' below-named attorney, Philip F. Fox, to facilitate allowance of the above-identified application.

No fee is believed necessary for filing with this Amendment. Nonetheless, the Commissioner is authorized to charge any additional fee(s) associated with this Amendment, including any fee(s) required under 37 C.F.R. 1.16 and 1.17 (or credit any overpayment(s)) to Deposit Account No.503549 of the Law Office of Philip F. Fox (Deposit Account Name). A duplicate copy of this communication is enclosed.

Respectfully submitted,

Date: December 1, 2005

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